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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

HUGHET, W

ART UNIT

PAPER NUMBER

2761

DATE MAILED:

01/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/804,900

Applicant(s)
Robert Mechaley, Richard A. Miner

Examiner
William N. Hugnet

Group Art Unit
2761



☒ Responsive to communication(s) filed on Nov 12, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Status of Claims

1. Of the original Claims 1 - 27, Claims 1 and 18 have been amended by Applicants' amendment filed November 12, 1998. Therefore, Claims 1 - 27 remain under prosecution in this application.

Summary of this Office Action

2. In light of the amended claims, the Examiner was required to conduct another prior art search and has applied the newly discovered art to the claims.

3. Applicants' arguments filed November 12, 1998 have been fully considered, are discussed in the next section below or within the following rejection under 35 U.S.C. § 103, and except as where expressly noted, are not deemed to be persuasive. Therefore, Claims 1 - 27 remain rejected under 35 U.S.C. § 103 as unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

Response to Applicants' Amendment

4. The Examiner acknowledges Applicants' amended title and therefore withdraws the prior office action's objection regarding this matter.

5. The Examiner acknowledges Applicants' amendment to independent claims 1 and 18 regarding the added language, "data processor implemented" and therefore withdraws the corresponding rejection under 35 U.S.C. § 101.

6. The Examiner acknowledges Applicants' amendment to the Specification regarding updated information on Application No. 08/316,635 and the language introducing Exhibit A and therefore withdraws the corresponding objection to the Specification. However, the objection regarding a reference to Application No.

08/861,792, for which a Notice of Allowance has been mailed, is maintained. 37 C.F.R. §1.77 requires a cross-reference to related applications, regardless of any dependency.

7. As regards Coffey failing to teach the offering of upgraded features to users, the Examiner respectfully notes that the CDMA article was introduced to disclose this feature.

8. As regards the CDMA article failing to teach the limitation of communicating to a user the availability of greater functionality as recited in the independent claims, CDMA expressly teaches such a feature at page 1, lines 36 and 37. To perform such a step by means of a data processing-implemented method is not inventive in the absence of unexpected results. *In re Venner*, 120 U.S.P.Q. 192, 194 (CCPA 1958) (noting that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result). Additionally, CDMA expressly teaches offering users upgrades at page 1, line 37, which the Examiner respectfully asserts is within the broad claim language of "communicating to a user . . . an availability of said greater functionality". See Specification at page 3, lines 23 - 24 regarding the invention's method of "brokering upgraded resources for enabling greater functionality".

9. As regards the propriety of combining the Coffey and CDMA references to render Applicants' invention obvious under 35 U.S.C. § 103, such a combination may proper if the references are in analogous subject areas. *In re Gorman*, 18 USPQ2d 1885, 1888 - 89 (CAFC 1991). Here, both Coffey and CDMA teach in the area of analyzing use of communications services (Coffey at abstract; CDMA at page 1, lines 22 - 25 and 36 - 37). Additionally, there must be a motivation to combine the references. *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1629-30 (CAFC 1996). The motivation to combine, as articulated below and in the prior office action, would be to provide the detail of how Coffey's logging of communications information may be analyzed and the results disseminated in the form of offering greater communications

functionality to qualified users (Coffey at Col 1, lines 24 - 28; CDMA at page 1, lines 36 - 37).

10. Applicants' remaining traversals are discussed under the 35 U.S.C. § 103 rejection below.

Drawings

11. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

12. The disclosure is objected to because of irregularities as noted on PTO 948. Appropriate correction is required.

Specification

13. The application is objected to as not being in compliance with 37 C.F.R. 1.77 regarding the required elements of the application. In particular, this application is lacking a section entitled, "Cross-References to Related Applications" which should reference copending application No. 08/861,792, filed May 22, 1997.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

15. Claims 1 - 27 are rejected under 35 USC § 103 as being unpatentable over Coffey et al. (U.S. Patent No. 5,675,510) in view of Jason Meyers, "CDMA Gets its Day in the Sun", Telephony, v 230, n 21, page 8, May 20, 1996 (hereinafter "CDMA").

(A) As to Claim 1, Coffey discloses a computer-based system for collecting data regarding usage of software products on a plurality of computers and corresponding users across a communications network (Coffey at abstract; Col 1, lines 36 - 50 and 57 - 64; Col 2, lines 1 - 11; Col 3, lines 45 - 47). The usage data is analyzed to produce information useful to marketing (Col 2, lines 62 - 67; Col 3, lines 25 - 28). Information requests are interactively communicated to the users (Col 3, lines 19 - 21). Although Coffey teaches that the system is useful to marketing, it does not expressly disclose offering upgraded features to users based on an identified pattern from the analyzed usage data. However, CDMA is an article disclosing the release of upgraded cellular services to the customers of AirTouch Communications, Inc. in the Los Angeles, California market. In particular, CDMA discloses offering greater cellular communications functionality based on past usage patterns (CDMA at page 1, lines 14 - 16 and 36 - 37). It would have been obvious to one of ordinary skill in the art of resource management to modify Coffey with the communications analysis and offering method of CDMA. Coffey discloses that there exists an intense need to measure use of computer related resources and disseminate related information (Coffey at Col 1, lines 24 - 28). Coffey also teaches that their invention helps satisfy this need by monitoring and logging certain external communications (Coffey at Col 2, lines 35 - 36). The motivation to modify the teachings of Coffey with those of CDMA would be to provide the detail of how the logging of

communications information may be analyzed and the results disseminated in the form of offering greater communications functionality to qualified users.

The Coffey/CDMA combination, therefore, is a computer-based system for collecting data regarding the usage of a plurality of software (Coffey at Col 2, lines 62 - 65) and communications products (Coffey at Col 2, lines 35 - 36; CDMA at page 1, lines 14 - 16 and 36 - 37), analyzing said data (Coffey at Col 2, lines 65 - 67; CDMA at page 1, lines 36 - 37), and offering product upgrades to qualified users (CDMA at page 1, lines 36 - 37).

(B) As to Claim 2, Coffey discloses collecting interval of use data (Col 3, lines 61 - 65).

(C) As to Claims 3 - 5, Coffey discloses collecting statistical, demographic, and geographic data (Col 3, lines 54 - 61; Col 4, lines 33 - 38).

(D) As to Claim 6, CDMA discloses determining whether a threshold has been exceeded as indicated by usage data such that the user is to be offered communications upgrades.

(E) As to Claim 7, although the Coffey/CDMA combination discloses analysis of product usage data to determine whether a data pattern can be identified, neither Coffey nor CDMA expressly teach application of a fuzzy algorithm to said analysis. However, the Examiner asserts that use of a fuzzy algorithm is merely a design choice from among a plurality of known analysis methods.

(F) As to Claim 8, Coffey discloses interactively communicating with users (Col 3, lines 19 - 21).

(G) As to Claim 9, the Examiner asserts that interactive voice communication is well known in the art and would have therefore been an obvious method of communication with the user.

(H) As to Claim 10, the Examiner asserts that computer displays and keyboards are well known means of communication between computer systems and users.

(I) As to Claim 11, Coffey discloses collecting data regarding user decisions to invoke various software products (Col 1, lines 57 - 62). The remaining limitations of Claim 11 are found in Claim 1, and the remainder of this claim is rejected for the same reasons.

(J) As to Claim 12, the Examiner asserts that the personal assistant system disclosed in the Specification at page 5, lines 18 - 20 cites to Application No. 08/316,635 (now U.S. Patent No. 5,652,789), which is disclosed therein to be a software product for facilitating communications (Miner at Col 1, lines 5 - 7; Col 10, lines 44 - 50). As such, the Examiner asserts that the recited personal assistant system falls within the class of software products of Coffey. Therefore, the limitations of Claim 12 are found in Claims 1 and 9, and this claim is rejected for the same reasons.

(K) The limitations of Claim 13 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(L) The limitations of Claim 14 are found in Claim 11, and this claim is rejected for the same reasons.

(M) The limitations of Claim 15 are found in Claims 8 and 9, and this claim is rejected for the same reasons.

(N) The limitations of Claim 16 are found in Claims 1 and 10, and this claim is rejected for the same reasons.

(O) As to Claim 17, CDMA discloses offering greater functionality dependent on usage patterns. The Examiner asserts that by being eligible for greater functionality, the users by necessity were started at a lower functionality level.

(P) The limitations of Claim 18 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(Q) The limitations of Claims 19 and 20 are found in Claims 2 and 3, respectively, and these claims are rejected for the same reasons.

(R) The limitations of Claim 21 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(S) The limitations of Claims 22 - 24 are found in Claims 1 - 3, respectively, and these claims are rejected for the same reasons.

(T) The limitations of Claim 25 are found in Claims 1 and 6, and this claim is rejected for the same reasons.

(U) The limitations of Claims 26 and 27 are found in Claims 2 and 3, respectively, and these claims are rejected for the same reasons.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Hugnet, whose telephone number is (703) 305-9770. The examiner can be reached on Monday through Friday from 8:00 a.m. to 5:00 p.m. .

Serial Number: 08/804,900
Art Unit: 2761

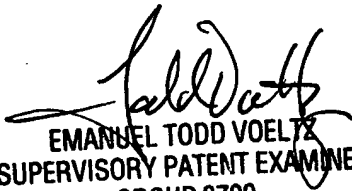
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached at (703) 305-9714. The fax phone number for this Group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

William N. Hughet
January 19, 1999
(08804900.AC2)

WNH


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